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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/767,599      | 01/30/2004  | Bernardo Ayala       | BA01-01U            | 5201             |

37038 7590 11/27/2006

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| EXAMINER |
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| ART UNIT | PAPER NUMBER |
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3611

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/767,599

Applicant(s)

AYALA, BERNARDO

Examiner

Cassandra Davis

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 11-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9 and 11-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson, U. S. Patent 6,604,840 in view of Yu, U. S. Patent 6,526,680 and Dalton et al. US 20040201992A1.

3. Watson teaches an illuminated sign comprising a frame structure 12 capable of retaining a replaceable image/sign 8, a power storage device 44 located within the frame structure 12, a variable power control device (photoelectric light switch 70) located within the frame structure, and plurality of LED light sources 50 located in front of the image to shine light onto the image/sign 8.

4. Watson does not teach the frame structure surrounding the image/sign. In addition, Watson does not teach the variable power control mechanism that varies the intensity of the LED light sources such that the intensity of the light source supplements ambient light or a frame structure surrounding the image/sign.

5. Dalton et al. teaches an illuminated means comprising a housing 11, light sources 2, a light dependent resistor (LDR) 750, and power supply in the form of a battery 620, 20. Dalton also teaches a circuit board which optionally contains a circuit that senses the ambient light and adjusts the brightness of the lights 2 in response to brightness of the ambient light. Dalton teaches the circuit will sense the ambient light and regulate the energy going to the lamps in proportion to the amount of the light that has been sensed. Thus, the light is decreased when the ambient light level is increased and the light is increased as the ambient light level decreases. See claims 24 and 25 of Dalton.

6. Yu teaches an illuminated license plate holder comprising a frame member 4 surrounding the license plate.

7. It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the illuminated sign taught by

Watson with the switch and circuit board taught by Dalton to provide a means to adjust the intensity of the light so that the sign is always visible regardless of the ambient or surrounding light.

8. It would have been obvious to one having ordinary skill in the art at time this invention was made to construct the illuminated sign taught by Watson and Dalton with a frame structure surrounding the image/sign as taught by Yu to provide a means to evenly illuminated the entire perimeter of the sign.

9. With respect to claim 2, 16, and 22, since the applicant does not disclose that making the frame of wood, plastic, or metal solves any stated problem or is for any particular purpose, it appears that constructing the frame of any suitable material as taught by Watson would perform equally well in storing and display the picture/sign.

10. With respect to claims 3, 4, 11, and 18, Watson teaches the power source is a rechargeable battery. See column 3, lines 26-27. With respect to claims 5, 12, and 19, Watson teaches the light source can be a LED, incandescent or other miniature lights. See column 3, lines 27-32.

11. With respect to claim 6, 9, 13, and 17, Watson teaches the sign is a flat panel with indicia thereon.

12. With respect to claim 7, 14, and 20, Dalton teaches a circuit board for electrically connecting various electrical components.

13. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson, U. S. Patent 6,604,840 in view of Yu, U. S. Patent 6,526,680 and Dalton et al. US 20040201992A1 as applied to claims 1 and 8 above, and further in view of Tanny et al., U. S. Patent 6,116,977. Tanny teaches a display device incorporating a sensing means which is capable of detecting changes in the ambient light level or sound level which occur when an individual passes in the vicinity of the light sensor. When a change is detected, a signal is sent to speaker. See column 2, lines 9-14. It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the device taught by Watson, Yu, and Dalton et al. with the sensor and speaker as taught by Tanny to bring attention to the display.

14. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson, U. S. Patent 6,604,840 in view of Yu, U. S. Patent 6,526,680 and Dalton et al. US 20040201992A1 as applied to claims 1 and 8 above, and further in view of Privas et al., U. S. Patent 6,390,648.

15. Privas teaches a display apparatus for works of art comprising a housing 50, translucent panel 52, power source 16, circuit 18, light source 22 and sensor 26. The sensor 26 may be a passive infrared sensor for detecting the presence of a person within close proximity to the device, wherein the term sensor is used to indicate either a motion or heat sensor. Upon detection of a person the sensor activates the light source 22.

16. It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the device taught by Watson, Yu, and Dalton et al. with a motion sensor as taught by Privas to provide a means to activate the light source upon detection of person or thing approaching the device.

### ***Response to Arguments***

17. Applicant's arguments filed October 5, 2006. have been fully considered but they are not persuasive.

18. The applicant argues present application has a priority date to a provisional application with serial number 60/469,110 filed May 12, 2003 which predates Dalton, US 2004/0201992 filed June 1, 2004. The examiner disagrees. Dalton is a U. S. application publication of an international application filed June 4, 2002. The WIPO publication of the international

application was published in English and designated the US, therefor the §102 (e) date is the international filing date or an earlier filing date for which benefit is properly sought. See MPEP 706.02(f)(1). In this case, the §102 (e) date of Dalton is June 18, 2001.

19. Similarly, the applicant argues Watson, US was filed published as US 2003/0099105 on May 29, 2003 and published as US 2003/0099105 on May 29, 2003. The pending application has a priority date to provisional application serial number 601469,110 that was filed on May 12, 2003 therefore predating the Watson publication date reference. The examiner disagrees; the §102 (e) date for Watson is the US filing date of November 27, 2001.

20. Regarding the rejection of claims 1-9 and 11-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson, in view of Yu, and Dalton et al., the applicant argues Watson discloses a plurality of LED light sources, while claim 1 discloses at least one (emphasis added). The examiner agrees. The examiner contends at a "plurality of LED light source" encompasses "at least one LED light source".

21. In addition, the applicant argues) Watson is for use with a street sign, while claim 1 discloses the use with artwork or a picture (emphasis added).



The examiner contends the sign corresponds to the claimed artwork or picture. The applicant does not claim limitation precluding the sign taught by Watson for corresponding to the claimed artwork or picture.

22. The applicant further argues the Dalton reference is related to an outside walkway illumination device and the applicant contends that it would not be obvious to combine illumination of a walkway with illumination of a picture or image. The applicant contends that the examiner has not shown motivation in a reference to combine the Dalton illumination with the street sign of Watson or the license plate of Yu. The examiner contends both Watson, Yu, and Dalton teach illuminated device, while Watson and Dalton teach devices comprising a sensor for sensing ambient light and providing power to the illuminate the light source and turn off the lights at the predetermined threshold. Finally, the applicant argues the examiner cites that the frame as used in Yu is to evenly illuminate the entire perimeter of the sign. The applicant maintains in claim 1 only a single light source is disclosed and there is no requirement for even illumination, just supplemental illumination. The examiner contends claim 1 discloses at least one LED light source. The claim provides for additional or a plurality

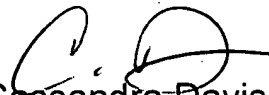
of LED light sources. The least number of LED light required by the claim is one.

23. The rejection is maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cassandra Davis whose telephone number is 571-272-6642. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cassandra Davis  
Primary Examiner  
Art Unit 3611

CD  
November 1, 2006